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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/728,898

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Hiroshi Ishikawa

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EXAMINER

TSOY, ELENA

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

07/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/728,898	Applicant(s) ISHIKAWA ET AL.	
	Examiner Elena Tsoy	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/4/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Amendment filed on May 12, 2008 has been entered. Claims 1, 5-9 are pending in the application. Claims 7-8 are withdrawn from consideration as directed to a non-elected invention.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 5, 6, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites film thickness of various layers in microns. However, it is not clear whether it is wet film thickness or dry one. For examining purposes the “film thickness” was interpreted according to the specification (See Example 1) as film thickness before curing, i.e. as “wet film” thickness.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panush (EP 0148718 A2) in view of Dattilo (US 6,291,018), further in view of Dutt (US 20040028823).

Panush is applied here for the same reasons as set forth in paragraph 4 of the Office Action mailed on 2/11/2008. Panush fails to teach that at least one color base coat includes first solid color layer and a second layer containing effect pigment (Claim 1).

Dattilo teaches that applying effect pigment-containing second basecoat layer over the first basecoat layer after flashing first basecoat material containing solid pigments provides polychromatic effect (See column 9, lines 3-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied first a solid color base coat, then after short flash a second effect pigment containing base coat with the expectation of providing the desired polychromatic effect, as taught by Dattilo.

Panush in view of Dattilo fails to teach that untinted clear coat is used instead of the tinted clear coat (Claim 1).

Dutt teaches that usually, applying a lightly pigmented clearcoat over a regular pigmented basecoat in the same color area, i.e., red over red, blue over blue, yellow over yellow, to significantly enhance the individual basecoat color shade and provide very deep, clean, vibrant, high end colors (See P3). However, the tinted clear coats are not durable (See P4). By replacing the tinted clear coat with a *regular untinted clear coat*, durability issues may be avoided, and the desired color enrichment may be obtained by using an intermediate basecoat layer instead of a tinted clearcoat (See P22). Dutt further teaches that a first basecoat may be solid color basecoat having a hiding power (See P27-28), and a second intermediate basecoat may have effect pigment (See P39).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced a tinted clear coat in a multi-layer coating of Panush in view of Dattilo with a regular *untinted* clear coat with the expectation of providing the multi-layer coating with the desired color enrichment and durable clear coat, as taught by Dutt.

All other claimed limitations would be obvious for the same reasons as set forth in paragraph 4 of the Office Action mailed on 2/11/2008.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Panush in view of Dattilo, further in view of Jackson et al (US 5962574) for the reasons of record set forth in paragraph 6 of the Office Action mailed on 5/11/2007.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 5, 6, 9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy, Ph.D.
Primary Examiner
Art Unit 1762

July 12, 2008

/Elena Tsoy /

Primary Examiner, Art Unit 1792